

Zhang et al.

S/N: 09/681,480

REMARKS

Claims 1-31 are pending in the present application. In the Office Action mailed June 4, 2004, the Examiner rejected claims 1-13, 24-28, and 30-31 under 35 U.S.C. § 102(b) as being anticipated by Dolphin (USP 5,677,953). The Examiner next rejected claims 14-23 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Dolphin in view of Hornbuckle (USP 5,388,211).

Information Disclosure Statement

The Examiner stated that the IDS filed May 18, 2001, "fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office." As such, the Examiner stated that the IDS was placed in the application file but the Examiner refused to consider the IDS.

Applicant is uncertain why the Examiner found the IDS objectionable. Applicant has simply made the Examiner aware of four co-pending patent applications that Applicant believed the Examiner might consider relevant to the examination of the instant application. In accordance with 37 CFR 1.98(a)(23), Applicant provided a listing of the serial numbers of the co-pending applications. That is, 37 CFR 1.98(a)(23) states that a listing must be provided of "all other information or that portion which caused to be listed, except that no copy of a U.S. patent application need be included." (Emphasis added). Therefore, Applicant believes the IDS filed May 18, 2001 to be in full compliance with all relevant statutes and rules. As such, Applicant respectfully requests full consideration of the IDS filed May 18, 2001, in accordance with the MPEP rules for handling of a properly-filed IDS. Nevertheless, should the Examiner believe any matters remain outstanding, Applicant asks that the Examiner provide a detailed explanation of why the Examiner finds the IDS objectionable so that Applicant may cure any actual deficiencies.

Rejections Under §102(b)

The Examiner summarily rejected claims 1, 4, 5, 8, and 24 and merely selected particular elements from the claims, but did not provide a corresponding citation to the art of record to address each and every element of the claims. While this rejection not only falls short of proffering a proper rejection under MPEP §2131, the citations provided by the Examiner are unsupportive for the propositions asserted. Specifically, for example, the Examiner asserted, "Dolphin disclose receiving an access request from a user of a remotely located device seeking access to an option resident in memory of the device in (col. 5, lines

Zhang et al.

S/N: 09/681,480

7: 13).” (Emphasis added). It appears the Examiner has ignored this distinction and has equated access to restriction to data, with access restriction to an option. However, when interpreting the claims in light of the specification it is clear that such an interpretation is not accurate. That is, upon review of the cited section, as well as numerous other sections of Dolphin, it is clear that the data to which the user is seeking access (1) is not “an option,” and (2) is not “resident in the memory of the device” as explicitly called for in the claims. See Col. 1, lns. 13-18.

Dolphin teaches a “system and method for access control for portable data storage media.” For example, see the title of Dolphin. Dolphin is further explicit that the “portable data storage media” may be either a CD-ROM, magnetic optical (MO), or a server. See Col. 2, lns. 39-44. Dolphin teaches that the data stored on the “portable media” is information such as would be published in “a monthly or bi-weekly periodical.” Col. 12, ln 64 to col. 13, ln. 4.

However, the access requests in the case at hand are not to periodical-type passive data, such as the magazine articles disclosed by Dolphin, but instead are requests to a particular “capability” of the device which was previously unavailable to a user. Specifically, the “options” called for are not passive data, such as the periodical-type data taught by Dolphin, but, rather, the options are previously disabled “device capabilities.” See Background of the Invention Section, ¶ 7. Therefore, Dolphin does not teach “receiving an access request... to an option” but rather is addressed to receiving an access request to data. See Col. 12, ln. 65 – col. 13, ln. 1. There is a stark distinction between “data” and “options in the device.”

Furthermore, the subsequent steps of determining, generating, transmitting, and automatically enabling are all specifically directed to enabling an option. The error in equating simple periodical data with disabled options or capabilities of the device is improper, and it also renders the Examiner’s statements with respect to steps (B)–(E) of claim 1 fatally flawed. Simply, Dolphin is expressly restricted to access control and enablement of “data,” which is defined as periodical-type data and is accordingly passive in nature. The claimed invention is directed to enabling options or capabilities of a device that far exceeds the requirements for access control regarding simple periodical-type data.

Additionally, Dolphin states that data is stored on the “portable data storage media,” which may be a CD-ROM, MO, or a server. See Col. 2, lns. 39-44. Nowhere does Dolphin teach that such “data,” which resides on a CD, MO, or server, can be resident in the memory

Zhang et al.

S/N: 09/681,480

of the device. This point is further illustrated in the very section cited by the Examiner in support of the rejection. That is, column 5, lines 7-13 and the preceding sections of the paragraph are related to operations and procedures that occur "[w]hen the user 26 loads the CD-ROM 22 into its CD-ROM reader." Col. 4, lns. 65-66. Nowhere does Dolphin teach that any disabled option can be stored resident in the memory of the device (i.e., the memory of the user computer). Therefore, Dolphin does not teach "receiving an access request from a user of a remotely located device seeking access to an option resident in the memory of the device." (Emphasis added). Rather, at best, Dolphin teaches receiving an access request from a user of a remotely located device seeking access to data that is resident on a CD-ROM or server.

The Examiner apparently acknowledged the distinctions illustrated above and the shortcomings of the rejection when later addressing claims 15-17 and 22 as rejected under §103(a). Specifically, the Examiner stated, "Dolphin does not specifically disclose [a] device having at least one disabled option resident on a computer programmed to control the device." As such, Applicant believes the Examiner's position with respect to claims 1, 4, 5, 8, and 24 is both inconsistent with the teachings and suggestions of Dolphin and also inconsistent with the Examiner's own later articulated position with respect to claims 15-17 and 22.

For at least these reasons, claim 1 is believed patentably distinct from the art of record. Claims 2-14 are also in condition for allowance at least pursuant to the chain of dependency. However, the rejection of claims 2-14 includes further errors that Applicant believes should be highlighted in order to alleviate such errors in the future.

For example, with respect to claim 13, the Examiner asserted that "Dolphin disclose [that] unqualified includes one of a delinquent account, an exhausted line of credit, a poor credit history, and a refusal to complete educational requirements and a customer status of qualified includes a nondelinquent account (col. 3, lines 39-45). (Emphasis added). However, the Examiner's assertion is squarely incorrect. That is, Dolphin does not teach, nor suggest, that any criteria for qualifying a user include whether the user has refused to complete educational requirements, as specifically called for in claim 13. Rather, Applicant believes such is wholly inconsistent with the express purpose of Dolphin. That is, as previously shown, Dolphin is directed to the dissemination and access control of periodical-type data. The sole purpose of the access control, as articulated in the very section cited by the Examiner, is to secure payment in exchange for access to the periodical-type data stored

Zhang et al.

S/N: 09/681,480

on either a CD-ROM or server. As one of ordinary skill in the art will readily recognize, "educational requirements" are simply not typically a prerequisite to accessing periodical-type data. In fact, Applicant believes that such would be wholly contrary to the intended purpose of periodical dissemination. That is, periodicals, by their nature, typically seek wide circulation, and the only qualification necessary for securing access to the data of the periodical is typically the purchase of the periodical. No "educational requirements" are thus taught or suggested, nor even consistent with the scope of Dolphin.

With respect to claim 24, the Examiner failed to address the particular elements specifically called for in the claim. Instead, the Examiner rejected claim 24 merely on the same basis as claim 1. This is improper under MPEP §2131, which requires that, in order to proffer a proper rejection under §102(b), the Examiner must first overcome the burden of establishing that the art of record teaches each and every element of each and every claim. The Examiner failed to meet this burden, and therefore, the rejection is not sustainable. Additionally, for at least the reasons stated above with respect to claim 1, the Examiner's rejection of claim 24 is insufficient because Dolphin does not teach that which is expressly called for within claim 24.

The failure to properly consider each and every limitation of the claims, as clearly illustrated with respect to claim 13, is indicative of an improper basis of rejection. That is, the Examiner failed to consider entire elements of the claims, and/or ignored the meaning of words within the claims. This point is further illustrated with respect to claim 25, which calls for a computer data signal forming a computer instruction to "include further instructions to transmit a renewal access request consistent with the terms of a previous grant of limited access." When providing a basis of rejection for claim 25, the Examiner cited to Fig. 13 of Dolphin. However, nowhere within Fig. 13, or the accompanying description of Fig. 13, is any such disclosure set forth. See Col. 11, ln. 60 to Col. 12, ln. 13. Rather, Fig. 13 and the accompanying description, are solely concerned with an initial access to the data contained on the portable media. Nowhere is any "renewal access request" disclosed, let alone "a renewal access consistent with the terms of the previous grant of limited access," as specifically called for in claim 25. Therefore, the Examiner's rejection of claim 25 should be withdrawn.

For at least the above reasons Applicant believes claim 24 to be in condition for allowance. Furthermore, for the above articulated reasons, as well as pursuant to the chain of dependency, Applicant believes claims 25-31 are each in condition for allowance.

Zhang et al.

S/N: 09/681,480

Rejections Under §103(a)

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Specifically, the MPEP is clear that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143

Applicant believes that a *prima facie* case of obviousness has not, and cannot, be made based on the art of record because, as will be shown below: (1) the references are directed to different purposes and there is no motivation to combine these references in a way done so by the Examiner; (2) the combination would not have a likelihood of success; and (3) all the elements of the present claims are not present in the references. The Examiner has not established the three basic criteria required under MPEP §2143 and therefore the rejection must be withdrawn.

Failure To Establish a Prima Facie Case Of Obviousness

With respect to claims 15-17 and 22, the Examiner asserted that "Dolphin disclose a centralized facility located remotely from the device and having at least one access computer programmed to receive from a qualified customer a request to access and use the disabled option." However, as previously shown with respect to claims 1 and 24, Dolphin does not

Zhang et al.

S/N: 09/681,480

teach enablement of “a disabled option,” but rather is expressly limited to access restriction of “data,” such as contained in periodicals. See col. 12, ln. 65 to col. 13, ln. 1.

Consistent with Applicant’s position, the Examiner did acknowledge that “Dolphin does not specifically disclose [a] device having at least one disabled option resident on a computer programmed to control the device.” However, the Examiner then cited column 2, lines 11–29 and column 3, lines 16–36 of Hornbuckle for such a teaching. With respect to the citation of column 2 of Hornbuckle, Applicant does not believe the subject matter contained therein is applicable to the claimed invention, whether in combination or otherwise. Specifically, the cited section is merely a synopsis of U.S. Patent No. 4,361,851 (‘851). According to the synopsis of the ‘851 patent included in Hornbuckle, the ‘851 patent teaches a traditional pay-per-view TV system. Applicant is uncertain how such traditional pay-per-view TV systems are applicable to the claimed invention and the Examiner has not provided any comments or guidance regarding the Examiner’s interpretation of the cited section of column 2.

Nevertheless, Applicant believes that a motivation to combine such a pay-per-view TV system with a system for access control of “portable data storage medium,” as taught in Dolphin, is wholly lacking because the two systems are unrelated and the Examiner has failed to establish otherwise. Furthermore, the access control for portable data storage of Dolphin, if combined with the synopsised pay-per-view TV system included in the cited section of Hornbuckle, certainly would not be likely to succeed in yielding the claimed invention for “remotely enabling software-based options.” Additionally, beyond failing to provide the requisite support for combining the references, as proposed by the Examiner, the Examiner also failed to show how or why the asserted combination teaches or suggests each and every element of claims 15–17 and 22.

Simply, as previously shown, Dolphin does not teach or suggest disabled options resident on a computer configured to control a device. Similarly, the summarized pay-per-view TV system fails to teach or suggest any disabled options resident on a computer configured to control a device. The Examiner cannot cited unrelated portions of unrelated references and contend, without support or explanation, that such meets the burden of establishing a *prima facie* case of obviousness.

The Examiner also cited to column 3, lines 16–36 of Hornbuckle in support of the rejection. While the section cited in column 3 at least pertains to the invention of Hornbuckle, rather than a prior art pay-per-view TV system, the cited section no more

Zhang et al.

S/N: 09/681,480

further the Examiner's rejection than the unrelated pay-per-view system. That is, the cited section nebulously discloses a "software rental system" that allows the user "to 'download' programs or data." Col. 3, lns. 27-29. Therefore, the cited section, as well as the remaining portions of Hornbuckle, are specifically directed to the "download" and rental of software to a specific "target computer." Hornbuckle does not contemplate "a device having at least one disabled option resident on a computer" prior to requesting access, as claimed. Therefore, the reference actually teaches away from the present invention. As is explicitly analogized within Hornbuckle, Hornbuckle's system is simply a pay-per-view system for software whereby, following payment, the target computer receives and may use the desired software. Col. 1, lns. 24-32. Hornbuckle does not teach, nor even suggest, that the software be disabled while resident on the end-user's computer.

As explicitly called for in claim 15, the option, while disabled, must be resident on a computer programmed to control the device. It is apparent, due to the proposed combination's failure to teach or suggest such, that both Dolphin and Hornbuckle do not render the claimed invention obvious because the combination would not be likely to succeed in yielding that which is claimed. The Examiner has failed to show that the combination teaches or suggests each and every element of the claims.

The shortcomings of the present rejection are particularly apparent through the Examiner's own statement that it would have been obvious "to employ remote control device taught in Hornbuckle with system control disclosed in Dolphin in order to increase the difficult[y] [for][sic] a would-be intruder to gain access to the computer." (Emphasis added). While Applicant does not necessarily agree or disagree with the Examiner's stated reasons why the offered combination would be obvious, such is irrelevant to the claimed invention. That is, the claimed invention is directed to a system and method of enabling previously-disabled options of a device remotely. Nowhere is the claimed invention concerned with increasing the difficulty for an intruder to infiltrate a computer.

The Examiner has cited unrelated art and has attempted to combine the art in a manner that is unrelated to the claimed invention. By way of the Examiner's own statements, it seems apparent that the Examiner has failed to establish a *prima facie* case of obviousness. Furthermore, the Examiner's basis for the offered combination is wholly unrelated to the claimed invention.

With respect to claim 21, the Examiner stated that "Dolphin discloses sending an electronic verification of receipt of the access request in (Fig. 1)." However, as expressly

Zhang et al.

S/N: 09/681,480

described by Dolphin, "Fig. 1 depicts the overall system of the present invention." Col. 3, ln. 48. Nowhere does the figure even relate to "sending an electronic verification of receipt of the access request." As accurately described by Dolphin, Fig. 1 simply relates to a system organization and in no way shows the sending or transmission of any type of verification receipt, let alone one in response to an access request. See Col. 3, ln. 48. The Examiner has cited unrelated figures and sections of references without any support or connection to the claimed invention. A word search without context to application is wholly ineffective. As such, Applicant contends claim 20 is patentably distinct from the art of record.

Official Notice

With respect to claims 14, 21, and 29, the Examiner took Official Notice that "it is well known in the art to use medical imaging scanner[s]." The Examiner's application of Official Notice is inappropriate under the Manual Patent Examining Procedure (MPEP). "The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP §2144.03 (emphasis added). However, MPEP §2144.03 is clear that "such rejections [relying on official notice] should be judiciously applied," be "rare," and be used "[i]n limited circumstances."

Furthermore, "any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection." MPEP §2144.03. Applicant does not believe that the Examiner's use of Official Notice is merely to "fill in the gaps in an insubstantial manner" and is therefore improper under the MPEP.

Official Notice Inappropriate Under MPEP §2144.03

The Examiner admitted that "Dolphin does not specifically disclose [a] device [that] includes at least one medical imaging scanner." However, the Examiner took Official Notice that "it is well known in the art to use medical imaging scanner[s]." The Examiner then concluded, "One of ordinary skill in the art would have been motivated to use medical imaging scanner[s] in order to improve efficiency [of] data processing in health care facilities." The Examiner failed to provide any support, logic, or reasoning as to why or in

Zhang et al.

S/N: 09/681,480

what manner “it is well known in the art to use medical imaging scanner[s].” Under this theory, no improvement patents could ever issue.

Furthermore, Applicant does not argue that medical imaging scanners are not well known. That is, Applicant has not claimed medical imaging scanner in the abstract. Rather, claims 14, 21, and 29 call for the “device,” which is clearly defined in the preceding claims as having elements uncommon to traditional medical imaging devices, to be a medical imaging scanner.

The Examiner’s statement that that “[o]ne of ordinary skill in the art would have been motivated to use medical imaging scanner[s] in order to improve efficiency [in] data processing in health care facilities” is irrelevant to the case at hand. Specifically, Applicant has not claimed the use of a medical imaging scanner “to improve efficiency [of] data processing in health care facilities.” Rather, when, for example, claim 14 is read in conjunction with claim 1, a method is claimed comprising:

- (A) receiving an access request from a user of a remotely located medical imaging scanner seeking access to an option resident in memory of the medical imaging scanner;
- (B) determining whether to grant limited access in response to the access request when a set of criteria has been met;
- (C) generating an electronic enabler configured to permit access to the option in response to an access grant;
- (D) transmitting the electronic enabler to the medical imaging scanner; and
- (E) automatically enabling customer access to the option in the medical imaging scanner in response to reception of the electronic enabler.

Upon proper review of the claims, it is clear that the Examiner’s statement that “[o]ne of ordinary skill in the art would have been motivated to use medical imaging scanner[s] in order to improve efficiency [of] data processing in health care facilities” is irrelevant to the case at hand. Furthermore, the Examiner’s application of Official Notice to three separate claims is hardly qualifies as a “judicious” or “rare” use of Official Notice.

Official Notice Traversed

The Examiner must “cite a reference in support of his or her position” should the Applicant traverse the assertion. MPEP § 2144.03. Furthermore, “[i]t is never appropriate to

Zhang et al.

S/N: 09/681,480

rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03 citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). "The requirement 'at the time the invention was made' is to avoid impermissible hindsight." MPEP §2141.01.

In the case at hand, Applicant disagrees with the Examiner's assertions, as illustrated above. Specifically, the Examiner has not shown that the *actual* claim elements were "well known" within the context of the invention at the time the invention was made. For at least these reasons, Applicant hereby traverses the use of Official Notice. Accordingly, a specific, relevant reference is hereby requested to support the Official Notice proffered by the Examiner.

In light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-31.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

Dated: 8/20/04
Attorney Docket No.: GEMS8081.062

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170